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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,560	07/30/2003	Janusz Jachowicz	FDN-2805	8640

7590 03/11/2011  
INTERNATIONAL SPECIALTY PRODUCTS  
Attn: William J. Davis, Esq.  
Legal Department, Building No. 10  
1361 Alps Road  
Wayne, NJ 07470

EXAMINER
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VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1619

MAIL DATE	DELIVERY MODE
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03/11/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/630,560

**Applicant(s)**

JACHOWICZ ET AL.

**Examiner**

JYOTHSNA VENKAT

**Art Unit**

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/23/10.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Receipt is acknowledged of remarks and declaration under 1.131 ( unexecuted) filed on 12/23/10.

#### **Status of claims**

**Claim 49 is cancelled.** Claims 1-48 are currently pending in the application.

#### **Claim Rejections - 35 USC § 102**

Claims 1-14 and 16-47 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent 7,223,294 ('294).

See col.11, line 22 through col.12, line 63 for the claimed cationic polymer formed from a, b and c. see the proviso at col.12, which states that if m and n are equal to zero, then p or q is equal to zero. See col.13, ll 4-13 for the species of cationic polymer and these are same as species claimed in claim 8. See col.21, line 54 through col.28, line 28 for the claimed conditioning agent, which is cationic polymer. See col.4, line 36 through col.6, line 45 for anionic polymer of claim 19, see col.28, line 29 through col.33, line 25 for amphoteric polymers of claim 20 and claims 35-39, see col.14, line 54 through col. 15, line 48 for nonionic polymer of claim 21 see especially col.15, under (4) this is same as claimed copolymers of alkyl acrylates and alkyl methacrylates, see col.15, ll 29-34 for claim 22, which is non-silicone polyurethanes. See col.34, ll 27-48 for claims 25-29 and 42, see col.34, ll 12-19 for claims 30-31, see col.16, line 65 through col.21, line 28 for claims 32-34, see col.34, ll 44-68 for claims 40-41 belonging to non-ionic surfactant, see col33, ll 26-33 for claim 43, see col.34, ll 1-111 for claim 44 and see col34, line 49 through col.35, ll 1-7 for claims 45-47.

### **Response to Arguments**

Applicant's arguments filed 12/23/10 have been fully considered but they are not persuasive.

Applicants' argue:

*"The Office Action alleges that this Declaration is not effective to overcome the rejections under s 102(e), because it was not signed by all of the inventors (Office Action, page 3). Accordingly, attached is a copy of a Declaration of Janus Jachowicz, Roger L. McMullen, Jr., Linda C. Foltis, Jean Karolak, Steve Orofino, Blanca Gomez and Ellen S. Botschka Under 37 C.F.R. § 1.131. Applicants are making their best efforts to obtain all seven signatures necessary, and will submit executed versions as soon as they are available.*

The Declaration attests to, inter alia, the following: As used throughout the disclosure of the present invention, and in Exhibit A of the Declaration, the abbreviation "DMAPMA" refers to dimethylaminopropylmethacrylamide. The particular polymers described in Exhibit A and disclosed to L'Oreal in this time period are vinyl pyrrolidone/DMAPMA/quaternized dimethylaminopropylmethacrylamide, where the quaternized portion was made by reacting DMAPMA with dodecyl chloride.

The Office Action alleges that the "ACP 1234" polymer "appears to correspond to [the] last polymer drawn to chloride species claimed in

claim 8, which is vinylpyrrolidone (VP)/dimethylaminopropylmethacrylamide (DMAPMA)/lauryldimethylmethacrylamidopropylammonium chloride terpolymer" (Office Action, page 3). The Office Action goes on to allege that the Declaration "failed to show that applicants' [sic] completed prior to the date of the reference all of the species shown in the reference" (Id. at page 4).

However, Applicants respectfully submit that the Declaration of the inventors clearly establishes that Applicants had possession of the invention as claimed in the '294 patent before the earliest priority date of the '294 patent. It is well-established that a species will anticipate a claim to a genus, and further that a reference that clearly names the claimed species anticipates the claim no matter how many other species are named. See MPEP § 2131.02, *In re Slayter*, 125 U.S.P.Q. 345,347 (C.C.P.A. 1960); *In re Gosteli*, 872 F.2d 1008, 10 U.S.P.Q.2d 1614 (Fed. Cir. 1989). Thus, because the material provided to L'Oreal prior to the priority date of the '294 patent anticipates, inter alia, the species recited in claim 8, the '294 is thus not a valid reference with regard to the presently *pending claims under 35 U.S.C. § 102(e)* “.

In response to the above argument, the declaration submitted 12/23/10 is ineffective since it is unexecuted. The declaration is also ineffective since patent '294 discloses several species of the claimed genus and this can be overcome by 1.131 only by showing that applicants'

completed prior to the date of reference or activity **all of the species shown in the reference. In re Stempel 113 USPQ 77**. See col.13, ll 4-13 for all the species within the claimed genus of patent '294.

*Applicants'* are requested to point out to the species in pending claims corresponding to "ACP 1234" shown in exhibit dated 4/28/10 and also described in the 1.131 declarations.

### **Claim Rejections - 35 USC § 103**

Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 7,223,294 ('294) and 6,540,791 ('791) and WO 01/41722 (WO document) and 6,984,250 ('250).

Examiner is relying on patent '250, which is English equivalent for WO document. Patent '294 does not disclose the limitation of claim 15, wherein the conditioning agent is drawn to various silicone compounds and limitation of claim 48, wherein the composition is an anhydrous composition. Patent '791 teaches bleaching compositions (personal care compositions for hair) using conditioning agents. Patent at col.4, line 50 through col. 22, line 41 teaches claimed silicone compounds as conditioning agents. Patent at col.26, ll 29 through col.30, line 32 teaches cationic polymers claimed in claim 14 also as conditioning agents. Thus patent teaches the equivalency between cationic polymers and silicones. Cationic polymers are taught in patent '294. Patent '791 also teaches claimed oxidative hair coloring agent, surfactants, and dyes. English equivalent of WO document, which is patent '250 teaches bleaching compositions (personal care compositions for hair) and teaches these compositions can be in anhydrous form at col.1, ll 39-41 and col2, ll 33-35.

Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '294 and substitute the conditioning agent, which is cationic polymer of patent '294 with silicones as the conditioning agent in view of equivalency between both the conditioning agents taught by patent '791, expecting silicones to provide conditioning property to hair and prepare the compositions in anhydrous form taught by WO document that personal compositions for hair ( bleaching ) can be an anhydrous form. This is a prima facie case of obviousness.

#### **Response to Arguments**

Applicant's arguments filed 12/23/10 have been fully considered but they are not persuasive.

Applicants' argue that patent '294 is not a valid reference in view of the 1.131 declaration.

In response, the declaration is ineffective for the reasons stated supra and patent '294 is a competent reference under 102 (e) and therefore 103 rejection is deemed proper for the reasons stated in the final rejection dated 3/27/09.

#### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA VENKAT whose telephone number is (571)272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT WAX can be reached on 571-272-0623. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /  
Primary Examiner, Art Unit 1619

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